

REMARKS

After entry of the here-enclosed amendment: Claims 1-36 are pending. Claims 1 and 4-24 are amended; Claim 37 is canceled and Claim 38 is newly added.

The Examiner has objected to the Specification and indicated that various headings must be included. Applicant has inserted by amendment each of the missing headings noted by the Examiner, in the appropriate place in the Specification. It is respectfully requested that the objections be withdrawn.

The Examiner has rejected claims 1, 3, 17-22, 25, 29, 30, 31, 32, 33, 34, and 35 under U.S.C. §102(b) over WO 0128368 (*Grzonka*). Applicant respectfully traverses that rejection.

The smoking article of Applicants' embodiments is structured to supply the smoker with different flavor characteristics between the initial puffs and the later puffs of the smoking article. This is accomplished by providing the smoking article with two discrete smokable segments joined in substantially end-to-end abutement. One segment is located adjacent the lit end of the smoking article in use and the other segment is located adjacent the mouth end of the smoking article. Only the segment adjacent the mouth end of the smoking article is provided with encapsulated flavorant. Accordingly in use the smoker experiences a pre-set sequence of sensorial characteristics. As the coal of the lit cigarette advances through the segment adjacent the lit end, there is no flavorant sensation delivered in the mainstream smoke. At the point where the segments abut, the burning coal comes into contact with the encapsulated flavorant and flavorant is thereby released and drawn with the mainstream smoke to the mouth end of the smoking article, providing the smoker with a different sensorial characteristic from that point on.

The reference to *Grzonka* discloses a cigarette with a construction which is quite different than Applicants' claimed embodiments. The *Grzonka* device is provided with a pair of filters, one at each end of a tobacco rod. The tobacco rod is in a single continuous segment with a uniform tobacco blend throughout, and no encapsulated flavorant therein. The filters at each end, however, differ in their construction so that one filter will deliver a lighter taste to the smoker than the other filter. One filter may also contain a flavor. The smoker then chooses which taste is preferred, and then severs the unwanted filter from the cigarette. The taste or flavor of the smoking material is determined by the chosen filter and remains constant throughout the smoking experience.

Thus there are a number of structural differences in the *Grzonka* cigarette as compared to the Applicants' embodiments of a smoking article.

The *Grzonka* device does not have one predetermined lit or mouth end. The smoker determines upon use which of the two ends of its cigarette will be the lit end by physically severing one of the two filters attached to the two ends thereof.

The *Grzonka* cigarette does not have a rod of smokable material comprising at least two discrete segments joined in end-to-end abutment. The *Grzonka* rod is comprised of a single segment only.

The *Grzonka* cigarette does not provide the smoker with two distinct flavor sensorial characteristics, one at the early puffs and another at the later puffs of the smoking device. The *Grzonka* cigarette has a one segment tobacco rod which delivers only one sensorial experience to the smoker, depending upon which filter the smoker chooses to use at the outset.

The only flavorant if used by the *Grzonka* cigarette, is situated in one of the *Grzonka*

filters. *Grzonka* does not disclose the use of encapsulated flavorant in one discrete section of a tobacco rod.

Accordingly, *Grzonka* fails in a number of respects to teach every element of both the article and method claims of the present application as required under 35 U.S.C. §102(b) (see M.P.E.P. §2131) and therefore Applicant respectfully requests the withdrawal of the Examiner's rejection thereof over *Grzonka*.

The Examiner has also rejected Claims 1, 2, 4, 5, 6, and 17 under 35 U.S.C. §102(b) over U.S. Patent 6,475,288 (*Oliver*). Applicant respectfully traverses that rejection.

The *Oliver* reference structure differs from the present application claims in a number of respects.

Oliver does not have a cigarette having a rod of smokable material comprising at least two discrete smokable segments joined in end-to-end abutment. The only components of *Oliver* joined in end-to-end abutment are the smokable rod (Fig. 6, "2" and "51") and the non-smokable filter (Fig. 6, "52").

Oliver does not have one discrete smokable segment adjacent the mouth end of its cigarette incorporating an encapsulated flavorant with the other discrete segment adjacent the lit end of the cigarette being devoid of any encapsulated flavorant.

The flavorant "2" of *Oliver* runs throughout the rod, therefore the smoker would not experience different flavor characteristics between the initial puffs and the later puffs.

Accordingly, the *Oliver* reference does not, in a number of respects, teach every element of both the article and method claims of the present application, M.P.E.P. §2131, as required under 35 U.S.C. §102(b) and therefore Applicant respectfully requests the

withdrawal of the Examiner's rejection thereof over *Oliver*.

The Examiner has rejected claims 7, 8, 9, 10, 11, 12, and 13 under 35 U.S.C. §103(a) over *Grzonka* in view of U.S. Patent Application Publication 2005/0039767 A1 (*Mua*). The deficiencies of *Grzonka* as a reference have been discussed above. Claims 7-13 depend directly or indirectly from Claim 1, and *Mua* fails to remedy those deficiencies of *Grzonka* as a reference as applied to Claim 1. Accordingly, claims 7-13 are patentable for the same reasons previously put forth for Claim 1. Moreover, while *Mua* teaches calcium carbonate may be added to a slurry for making bandcast reconstituted tobacco sheet, which may also contain a desired flavoring, there is no teaching in *Mua* that an encapsulated flavorant has a carbonate applied onto or present on the encapsulated flavorant to reduce particulate matter delivered to the consumer during smoking.

Claim 14 has been rejected under 35 U.S.C. §103(a) over *Grzonka* in view of U.S. Patent 4,785,833 (*Holzner*). Applicant respectfully traverses that rejection.

Claim 14 depends directly from Claim 1, and the patentability of Claim 1 over *Grzonka* has been fully discussed above. *Holzner* does not remedy the previously discussed defects of *Grzonka* as a reference.

Claims 15 and 16 have been rejected under 35 U.S.C. §103(a) over *Grzonka* in view of U.S. Patent 4,595,024 (*Greene*). Claims 15 and 16 depend directly or indirectly from Claim 1, and the patentability of Claim 1 over *Grzonka* has been discussed above. *Greene* does not cure the previously discussed deficiencies of *Grzonka* as a reference.

Claim 23 has been rejected under 35 U.S.C. §103(a) over *Grzonka* in view of U.S. Patent 4,587,982 (*Adams*). Claim 23 depends indirectly from Claim 1, the patentability of

which over *Grzonka* has been fully discussed above. *Adams* does not cure the previously discussed deficiencies of *Grzonka* as a reference.

Claim 24 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Grzonka* and *Greene* and further in view of U.S. Patent 5,137,036 (*Southwick*). Claim 24 depends indirectly from Claim 1, the patentability of which over *Grzonka* has been discussed previously. The references to *Greene* and *Southwick* do not overcome the deficiencies of *Grzonka* as a reference, previously discussed.

Claims 26, 27 have been rejected under 35 U.S.C. §103(a) over *Grzonka* in view of *Mua*. Claims 26 and 27 depend directly or indirectly from Claim 25 which incorporates the recitations of Claim 1 with regard to the structure of Applicant's smoking article embodiments. The patentability of Claim 1 over *Grzonka* has been previously discussed, and *Mua* does not overcome the previously discussed deficiencies of *Grzonka* as a reference.

Claim 28 has been rejected under 35 U.S.C. §103(a) over *Grzonka* in view of *Oliver*. Claim 28 depends directly from Claim 25 and the patentability of Claim 25 over *Grzonka* has been discussed previously. The reference to *Oliver* does not overcome the previously discussed deficiencies of *Grzonka* as a reference.

Claim 36 has been rejected under 35 U.S.C. §103(a) over *Grzonka* in view of *Southwick*. Claim 36 depends from Claim 25, the patentability of which over *Grzonka* has been discussed above in relation to Claim 1. The *Southwick* reference does not cure the deficiencies of *Grzonka* as a reference, as discussed above.

Applicant has added a new Claim 38 which depends directly from Claim 1. It is submitted that Claim 38 is patentable for the reasons given for Claim 1.

Accordingly it is submitted that Claims 7-16, 23, 24, 26, 27, 28, and 36, all of which have been rejected, are patentable for the reasons given above, and it is respectfully requested that the rejections thereof be withdrawn.

In view of the above, it is submitted that the Application is now in condition for allowance, and such action is respectfully requested.

The Examiner is invited to contact the undersigned attorney by phone if there are any further issues needing discussion.

Respectfully submitted,

/Charles I. Sherman/

Charles I. Sherman, Reg. No. 22,998
MIDDLETON REUTLINGER
Ph (502) 625-2745
2500 Brown & Williamson Tower
Louisville, Kentucky 40202
csherman@middreut.com

Date: October 22, 2009